

Remarks

Claims 11, 27-32, and 37 are pending in the subject application. By this Amendment, Applicant has canceled claims 28 and 33-36, amended claims 11, 27, 29, and 37, and added new claims 41-50. Support for the amendments and new claims can be found throughout the subject specification and in the claims as originally filed (see, for example, page 7, lines 21-31; page 9, line 17 through page 16, line 21). Entry and consideration of the amendments presented herein is respectfully requested. Accordingly, claims 11, 27, 29-32, 37, and 41-50 are currently before the Examiner. Favorable consideration of the pending claims is respectfully requested.

As an initial matter, the Examiner indicates that the Dutrillaux *et al.* reference cited as "M" on the Information Disclosure Statement filed May 29, 2005 has not been considered because it is not in English. In fulfillment of Applicant's duty to provide an explanation of the relevance of foreign language document, Applicant would like to bring to the Examiner's attention a Supplemental Information Disclosure Statement which is being submitted in conjunction with the filing of this Amendment. Applicant respectfully requests that the reference be considered and made of record by the Examiner in the subject application.

Claims 11 and 27-32 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Applicant has amended claims 11 and 27 to correct the antecedent basis issue identified for claim 11 in the Office Action and to clarify the primers and their use in claims 27 and 29-32. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Claim 11 is rejected under 35 U.S.C. § 102(b) as anticipated by Wilgenbus *et al.* (1995). The Office Action argues that Wilgenbus *et al.* anticipate the claimed invention. As the Patent Office is aware, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is respectfully submitted that Wilgenbus *et al.* (1995) fail to anticipate the claims as the reference fails to teach the labeling of primers with the recited fluorophores. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

Claim 37 is rejected under 35 U.S.C. § 103(a) as obvious over Speicher *et al.* (1996) in view of Siciliano *et al.* (U.S. Patent No. 5,538,869). The Office Action argues that Speicher *et al.* teach a combination of the fluorophore Cy7, the excitation filter Omega 740DF25 and the emission filter Omega 780EFLP. The Office Action also indicates that Speicher *et al.* fail to teach a kit. The Office Action argues that Siciliano *et al.* renders the claimed kit obvious as it teaches kits and because it was conventional in the art at the time of the invention to package together reagents into a kit for the convenience of practicing methods that required the reagents. Applicant traverses.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Applicant respectfully submits that the combination of cited references fail to establish a *prima facie* case of obviousness for the claimed invention as it fails to teach or suggest all the limitations recited within the claims. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

Claims 27-32 are rejected under 35 U.S.C. §103(a) as obvious over Lichter *et al.* (1990), Lengauer *et al.* (1990), or Wilgenbus *et al.* (1995) in view of Speicher *et al.* (1996). The Office Action states that the Wilgenbus *et al.* reference teaches a method comprising mixing first and second amplification products obtained from two IRS-PCR amplification reactions from chromosomes, wherein the first amplification products are obtained using Alu- and LINE-specific primers and the second amplification products are obtained using Alu-specific primers. The Office Action indicates that the Speicher *et al.* reference teaches a combination of the fluorophore Cy7, the excitation filter Omega 740DF25, and the emission filter Omega 780EFLP. The Office Action further indicates that the Lichter *et al.*, Lengauer *et al.*, and Wilgenbus *et al.* references teach using probes obtained by IRS-PCR amplification using primers specific for Alu and LINE DNA sequences in FISH analysis. Applicant respectfully traverses.

As indicated above, all the claim limitations must be taught or suggested by the prior art in order to establish the *prima facie* obviousness of a claimed invention. Applicant, again, respectfully submits that the cited combination of references fails to render the claimed invention obvious as they fail to teach or suggest the recited fluorophore and filter combinations. As the combination of references fail to teach or suggest the recited claim limitations, it is respectfully submitted that a

*prima facie* case of obviousness has not been established and withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

Claim 11 is rejected under the doctrine of “obviousness-type” double patenting over claim 1 of U.S. Patent No. 6,562,959 and claim 37 is rejected under the doctrine of “obviousness-type” double patenting over claim 10 of U.S. Patent No. 6,562,959. Additionally, claims 11 and 27-32 have been provisionally rejected under the doctrine of “obviousness-type” double patenting over the claims of co-pending Application No. 10/251,699 (now U.S. Patent No. 6,905,828). Applicants have concurrently filed a Terminal Disclaimer in this matter and respectfully submit that these rejections are now moot. Accordingly, reconsideration and withdrawal of the rejections is respectfully requested.

It should be understood that the amendments presented herein have been made solely to expedite prosecution of the subject application to completion and should not be construed as an indication of Applicant’s agreement with or acquiescence in the Examiner’s position. Applicant expressly reserves the right to pursue the invention(s) disclosed in the subject application, including any subject matter canceled or not pursued during prosecution of the subject application, in a related application.

In view of the foregoing remarks and amendments to the claims, Applicant believes that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Applicant invites the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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